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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,568	08/30/2001	John S. Erickson	1509-215	6171

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/941,568	<b>Applicant(s)</b> ERICKSON ET AL.	
	<b>Examiner</b> Firmin Backer	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conant et al (U.S. PG Pub. No. 2002/0129056) in view of Ginter et al (U.S. PG Pub No. 2004/0133793).
3. As per claims 1, 9 and 10, Conant et al teach an apparatus for determining the output of a contract or agreement at any point in time as required, comprising means for creating a state machine representative of the contract or agreement at least some of the clauses and/or conditions of the contract or agreement being represented as a respective state variable of the state machine, means for storing the state machine, means for receiving data representative of one or more events relevant to the contract or agreement, determining whether the event changes the status of the state machine changing the status of the state machine if required (*paragraphs 0004, 0006, 0025, 0036, 0037, 0040, 0043, 0047, 0056*). Conant et al fail to teach an inventive concept of right or obligation and determining the right or obligation in response to the received data and the status of the state machine. However, Ginter teaches an inventive concept of right or obligation and determining the right or obligation in response to the received data and the status

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of the state machine (*see paragraphs 1969*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Conant et al's to include Ginter et al's an inventive concept of determining the right or obligation in response to the received data and the status of the state machine because this would have provide a system that facilitate contract agreement.

4. As per claims 2, Conant et al teach an apparatus comprising means for storing a plurality of state machines, each representative of a respective contract or agreement, the output of each the contract or agreement being determinable concurrently as required (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

5. As per claims 3, Conant et al teach an apparatus wherein the computer language used to realize the apparatus is an object-orientated computer language, such that the output of a contract state machine object are assertions that the object makes to other objects or systems (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

6. As per claims 4, Conant et al teach an apparatus including software components or systems which receive the output assertions of the virtual contract, and determine and implement the "wishes" or "intentions" of the contracts, as required (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

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7. As per claims 5, Conant et al teach an apparatus comprising a kernel including means for storing a plurality of contract or agreements in the form of state machines, means for receiving information regarding events relevant to one or more of the contracts or agreements, and means for changing the state of one or more of the state machines as required according to the event (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

8. As per claims 6, Conant et al teach an apparatus comprising an event queue which accommodates "external" and "internal" events (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

9. As per claims 7, Conant et al teach an apparatus wherein if the state of a contract or agreement is not changed for a predetermined period of time, the contract is persisted to storage means to await the occurrence of one or more events which effect its behaviour or output (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

10. As per claims 8, Conant et al teach an apparatus wherein upon initialisation, virtual contracts are registered with a virtual contract manager such that they can subscribe to events that affect their behaviour to output at any given time (*paragraphs 0004, 0006, 0025, 0036, 0037. 0040, 0043, 0047, 0056*).

11. As per claims 11-18, they disclose the same inventive concept as disclosed in claims 1-10. Therefore, they are rejected under the same rationale.

***Response to Arguments***

12. Applicant's arguments filed April 21<sup>st</sup>, 2005 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art fail to teach an inventive concept indicating data representative of one or more events representative of performance of at least one or more parties or the one or more events relative to the contract agreement. Examiner respectfully disagrees with Applicant's characterization of the prior art. Conant teach a method and apparatus provide a capability for electronic negotiation of the content of a document. This electronic negotiation tool can be applied to business transaction documents such as contracts, requests for proposals, engineering design documents and other like documents. The tool permits the first party, having one or more individual users, to access a database of document content and construct a draft of the document. *In one example the draft document constitutes a draft contract either selected from a library of contracts associated with the first party or created from a selection of standard clauses in a standard clause database associated with the first party (emphasis added).* The second party, which may also include one or more individual users, receives a notification of the existence of and the location of the document and is provided with certain revision privileges. In one example the second party is permitted to negotiate the document on a *clause-by-clause* basis and in another configuration the second party is permitted to negotiate only on a contract-as-a-whole basis. As the second party proposes revisions to the contract those revisions are maintained and a history file is created in

association with the contract. The first and the second party are provided with editing privileges in a manner that guarantees that a party has the most up-to-date revision of the document. *A series of reports to track risk, revenue, outstanding obligations, word usage and execution of nonstandard clauses are run. To the extent that the report provides information about obligations this will allow a subscriber to better manage those current obligations and avoid potential noncompliance issues (emphasis added).* Obligations can be cross-referenced with clause related revenue to gauge the amount of revenue attached to outstanding obligations. Risk management reports will aid a subscriber in evaluating the number of high-risk clauses agreed upon and outstanding revenue attached to those high-risk clauses. To the extent that the system tracks the modification of clauses it is possible also to generate reports about modified clauses to inform subscribers about language that is frequently negotiated and to allow them to refine that language to expedite future negotiations. To the extent that the series of reports are run and generated represent performance of parties involving in the contract negotiation. For the above reason the rejection is maintained.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

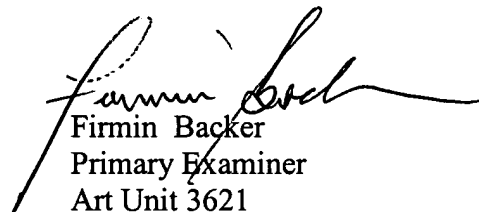
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Firmin Backer  
Primary Examiner  
Art Unit 3621

June 9, 2005